

### **REMARKS**

In the Official Action Dated May 12, 2009, the Office rejected claims 9 and 31 under 35 U.S.C. § 112, (1<sup>st</sup> and 2<sup>nd</sup> Paragraphs). Claim 30 was allowed.

In this paper, Applicants have responded to each of the claim rejections. All amendments have been made to place the claims in condition for allowance.

These amendments are all supported by the specification as filed. No new matter has been added. Applicants preserve the right to file continuing patent applications on any subject matter that has been cancelled from the claims, including any cancelled claims.

#### **Objection to the Abstract of the Disclosure**

The Office suggested that the compound of Formula IV be inserted into the Abstract of the disclosure. For the sole purpose of expediting prosecution, Applicants have replaced the Abstract of the disclosure to have the compound of Formula IV in the Abstract of the disclosure. Accordingly, this objection has been rendered moot by way of this amendment. Applicants respectfully request reconsideration and withdrawal of this objection.

#### **Rejections under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

The Office rejected claim 9 under 35 U.S.C. § 112, first paragraph, stating that one  $R^2$  is possible, n is 0-4 is possible, and that variable m does not occur in formula IV.

For the purpose of expediting prosecution, Applicants have (1) amended claim 9 to define  $R^2$  as occurring only once, (2) defined n as 0-4 and (3) deleted the definition of m.

Accordingly, this rejection has been obviated by way of these amendments. Applicants respectfully request reconsideration and removal of this rejection.

Rejections under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph

The Office rejected claims 9 and 31 under 35 U.S.C. § 112, first paragraph, alleging that the compounds encompassed in claims 9 and 31 are not enabled. Applicants respectfully traverse.

In regard to R<sup>3</sup>, R<sup>3</sup> has been amended without prejudice to be selected from -H and optionally substituted lower alkyl, and this amendment is supported by the specification as filed. Applicants respectfully point out that R<sup>3</sup> is an optionally substituted lower alkyl in compound 62 in Table 3 of the specification. Thus R<sup>3</sup> is also enabled by the specification as filed, as well as by knowledge to one skilled in the art at the time the application was filed.

In regard to R<sup>6</sup>, R<sup>6</sup> has been amended without prejudice to be -H or optionally substituted lower alkyl, and this amendment is supported by the specification as filed. Applicants respectfully point out that R<sup>6</sup> is an optionally substituted lower alkyl in compound 49 in Table 3 of the specification. Thus R<sup>6</sup> is also enabled by the specification as filed, as well as knowledge to one skilled in the art at the time the application was filed.

In regard to variables R<sup>1</sup>, R<sup>2</sup> and X, Applicants respectfully point out that in Table 3, compound numbers 9, 12, 15, 18, 31, 33, 45-46, 48-50, and 63 are compounds in which R<sup>1</sup> and R<sup>2</sup> join together with the corresponding carbon atoms to which they are attached to form a second ring. In addition, compound numbers 33, 45-46, 48 all have hydroxyl group on the ring to which R<sup>1</sup>, R<sup>2</sup> and X are attached. In addition to this, all of the remaining groups defined in R<sup>1</sup>, R<sup>2</sup>, R<sup>4</sup>, R<sup>5</sup> and X are common groups that were known in the art at the time the instant application was filed which the skilled artisan could have added onto ring systems by techniques that were known in the art at the time the instant application was filed. Schemes 1-10 and Examples 1-3 in the specification, in addition to all of the known chemical groups and known synthetic techniques that could have been used to add these groups, which were known in the art at the time the instant application was filed, enabled the skilled artisan how to generally make compounds encompassed by the pending claims at the time the instant application was filed.

Accordingly, Applicants respectfully request withdrawal and reconsideration of this rejection under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph.

Applicants respectfully submit that the present application is in condition for allowance, which action is earnestly solicited.

No fees are believed to be due in order to process this document and any paper attached. Should the U.S. Patent Office determine that an extension of time and/or other relief is required at this time, the Commissioner is authorized to charge the cost of such relief and/or fees to Deposit Account No. 50-1108, referencing EX04-019C-US.

Respectfully submitted,

Date: August 11, 2009

/ROBERT L. BERNSTEIN/

Robert L. Bernstein, Reg. No. 46,020  
Attorney for Applicants

**Exelixis, Inc.**

*Physical Address:*

249 East Grand Avenue  
South San Francisco, CA 94080

*Mailing Address:*

Post Office Box 511  
South San Francisco, CA 94083-0511

Direct Phone: (650) 837-7352

Fax: (650) 837-8234